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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,196	01/29/2004	Anthony Balloutine	390.0002	2257
25534	7590	03/08/2005		
CAHN & SAMUELS LLP 2000 P STREET NW SUITE 200 WASHINGTON, DC 20036			EXAMINER SUHOL, DMITRY	
			ART UNIT 3714	PAPER NUMBER

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/766,196

Applicant(s)

BALLOUTINE, ANTHONY

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/29/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 7 states that the activating cover sheet contains an oxidizing agent which causes the substance on the writing surface to disappear, however the specification discloses two embodiments one which teaches a sheet containing a disappearing ink covered with a barrier sheet which when lifted exposes the ink to air (i.e. an oxidizer) which in turn causes the ink to "disappear". The second embodiment discloses a similar invention but one that is uncovered until the desired "disappearance" of the ink. In the case of claim 7 it would appear that applicants are claiming that the ink only disappears if a sheet carrying an oxidizer is introduced to the ink, however such structure was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It would appear that the ink would disappear long before the oxidized sheet is introduced due to the inks contact with the surrounding air which would act as an oxidizer (much

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like applicants first embodiment. It appears that claim 7 inappropriately combines applicants first and second embodiment with out clearly fulfilling the enablement requirement.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Sherman '849. Sherman discloses a device containing all the elements of the claims including, a marked area (surface 14) having ink capable of disappearing (ink 3), an overlying barrier sheet (12) for preventing permeation of air which is removably affixed to the marking surface (col. 3, lines 4-11).

Claim 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuhns et al '732. Kuhns discloses a guidance system containing all of the claimed elements including, a writing surface (read onto paper core 15) including a guidance means (23 and 25) formed of a substance capable of disappearing (col. 7, lines 3-10) and an activating cover for initiating a reaction process (read onto cover 5 since the guides of Kuhns disappear after the cover is laminated to the paper sheer 15 as stated in col. 7,

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lines 3-10). The activating sheet cover being a synthetic polymer, as required by claim 8, is shown as the plastic sheet 5 (see col. 3, lines 51-52)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman '849. Although Sherman discloses all of the claim limitations, as stated above, the reference fails to explicitly teach a barrier sheet of synthetic polymer material as required by claim 2, a barrier sheet being of a lightweight aluminum foil as required by claim 3, a plurality of lines (a penmanship improving indicia as required by claim 10) formed from a disappearing ink as required by claim 4 and a series of instructions located on the barrier sheet as required by claim 5. However, it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have manufactured the barrier sheet of Sherman from a synthetic polymer or a lightweight aluminum foil since Sherman does not put forth any constraints regarding the materials used in the manufacture of his barrier (10) but that the barrier prevents air or light from reaching the reactive ink of his invention and the use of any of the above materials would be capable of fulfilling such a function. Furthermore, the specific materials of manufacture of the barrier sheet of applicants invention are considered to

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be a design choice in that applicants clearly admit that (much like Sherman) any materials may be used with the only constraint being that the barrier prevent the ink from being exposed to air (see applicants specification page 5, lines 3-9).

Regarding the limitations of claim 4 and 10, Sherman discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time of the claimed invention to provide the disappearing ink of Sherman in an arrangement of straight lines since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of disappearing indicia and guide means does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. a plurality of lines) and the substrate (e.g. the carrier sheet/substrate) which is required for patentability.

Regarding the instructions as required by claim 5, it would have been obvious to include a series of instructions located on the barrier sheet of Sherman for the purpose of providing instructions to the user of the device especially since the examiner takes

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official notice that such construction is conventional (i.e. peel back covers often have instructions stating items like "peel back here", or "pull up and peel back", etc).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuhns et al '732. Although Kuhns discloses all of the claim limitations, as stated above, the reference fails to explicitly teach an activation sheet of a lightweight aluminum foil as required by claim 9. However, the specific materials of manufacture of the activation sheet of applicants invention are considered to be a design choice in that applicants clearly admit that any materials may be used and in fact clearly state that a synthetic polymer is the preferred choice of materials (see applicants specification page 7, paragraph 0030).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol  
Examiner  
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